

App. No. 10/706,234
Attorney Docket 3055.2.1 NP

Amendments to the Drawings

None

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Remarks

Applicant thanks the Examiner for the Written Office Action.

With regards to the substantive portion of the Written Office Action, Claims 1 – 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stanfield US 2002/0069093 in view of Vivadelli et al US 2004/0267623. Claim 20 was not discussed in the Written Office Action.

Claims 1, 11, and 20 are amended in response to the Written Office Action. In particular, Independent claims 1, 11, and 22 have been amended to include the limitations of Claim 8.

Under 35 U.S.C. §103 the Examiner has the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). The Applicant respectfully notes that the Written Office Action failed to present a *prima facie* case of obviousness in regards to the limitations of Claim 8, wherein such limitations are not taught by the art of record and no such assertion is made. Accordingly, the Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Further, the Applicant respectfully asserts that the combination of Standfield and Vivadelli et al is improper use of hindsight. In particular, the motivation to combine noted in the Written Office Action “[t]his would allow for a customer to self check-in at a remote location, thus increasing the convenience of the system” impermissibly reasons a combination motivated by the Applicants disclosure and not from the art of record.

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It is well settled that hindsight is not a proper basis for rejecting the claims.

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U.S.P.Q.2d 1377 (Fed. Cir. 1993). "The motivation to combine references cannot come from the invention itself" but must instead come from the prior art. Id. "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. . . . This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'" In re Fritch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Further, "[i]t is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990) See e.g. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed.Cir.1985). To establish *prima facie* obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings to arrive at the claimed invention. "The teaching or suggestion to make the claimed combination ... must be found in the prior art, not in applicant's disclosure." MPEP 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." See *MPEP 2143.01*, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

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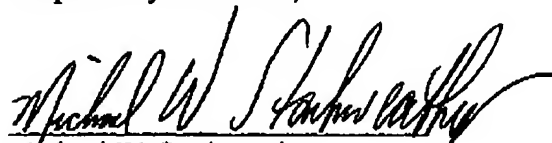
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Accordingly, the Applicant respectfully requests that the rejection under 35
U.S.C. § 103(a) be withdrawn.

It is believed that none of the prior art teaches the claimed invention.

Furthermore, it is believed that the foregoing amendment has adequate support in the
specification, and accordingly there should be no new matter. Applicant believes the
pending claims have addressed each of the issues pointed out by the Examiner in the
Office Action. In light of the foregoing amendment, the claims should be in a condition
for allowance. Should the Examiner wish to discuss any of the proposed changes,
Applicant again invites the Examiner to do so by telephone conference.

Respectfully Submitted,



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Date: 3/16/06

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